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EXAMINER
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PIERCE, WILLIAM M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHRIS BANCEL, RICH ALLEN,  
and JONATHAN AVERY

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Appeal 2016-005088  
Application 13/871,531  
Technology Center 3700

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Before JILL D. HILL, JAMES J. MAYBERRY, and SEAN P. O'HANLON,  
*Administrative Patent Judges.*

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Chris Bancel et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's non-final decision rejecting claims 1–29 and 31. Appellants' representative presented oral argument on February 23, 2017. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## BACKGROUND

Independent claims 1 and 31 are pending. Independent claim 1, reproduced below, illustrates the claimed invention.

1. A system configured to facilitate a plurality of players to compete and wager with one another in a puzzle-based game, the system comprising:

a data processing system having a computer configured to:

provide each player with a respective puzzle component having a predefined solution;

enable each player to interact with their respective puzzle component during each of a plurality of timed rounds;

determine a respective score for each player based on a progress made toward the predefined solution during an interaction with their respective puzzle component, the interaction made during at least one of the plurality of timed rounds;

enable each player to place a wager; and

determine a winner based on the respective score determined for each player.

## REJECTIONS

Claims 1–29 and 31 stand rejected on the ground of non-statutory double patenting. Non-Final Act. 4.

Claims 1–29 and 31 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. *Id.* at 4.

Claims 1–29 and 31 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. *Id.* at 5.

Claims 1–29 and 31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Samberg (US 6,572,111 B1; iss. June 3, 2003). *Id.* at 15.

## OPINION

### *Double Patenting*

Appellants do not refute the double patenting rejection in the Appeal Brief. Appeal Br. 2 n.1. We therefore summarily sustain the double patenting rejection.

### *Indefiniteness*

The Examiner finds that Appellants' independent claims 1 and 31 are indefinite because they claim both an apparatus and a method for using the apparatus. Non-Final Act. 4 (citing *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303 (Fed. Cir. 2011)). Appellants argue that the rejection is "ambiguous" and "legally deficient." Appeal Br. 4. The Examiner explains that the claims "call[] for both a combination of elements in a data processor in combination with puzzle components as though the claim was directed to an apparatus[,] and the physical steps by which a game is played, such as enabling players and determining." Ans. 3. Appellants argue that the claims do not recite "enabling" and "determining" as the Examiner contends. Rather, the claims recite a data processing system configured to provide, enable, and determine. Reply Br. 2.

We agree with Appellants. The recited "configured to" limitations are appropriate functional language, rather than method steps, and as such do not invoke the prohibition in *Katz*. We do not sustain the indefiniteness rejection.

### *Prior Art*

The Examiner finds that Samberg discloses, *inter alia*, a data processing system configured to provide each of plural players with a puzzle

component having a predefined solution. Non-Final Act. 16. The Examiner finds that Samberg's Gin Rummy hand is a puzzle component. *Id.* The Examiner further finds that "the melds of cards taught by Samberg are considered to [be] a predefined solution." *Id.*

Appellants argue that "even assuming *arguendo* that a rummy hand of Samberg teaches a puzzle component, a rummy hand does not have a predefined solution because any arrangement of the cards in the hand is *variable* based on cards that are randomly dealt from a deck of cards." Appeal Br. 20 (citing Samberg 3:9–25).

The Examiner responds that the claims do not recite "a non-variable solution," and that the term "predefined solution" is "broad and subjective and pertains only to how the puzzle components are intended to be used," and therefore cannot be relied upon to distinguish over the prior art. Ans. 11. The Examiner finds Samberg's "combinations of card sets or melds that a player attempts to achieve" have a "predefined solution." *Id.*

Claims 1 and 31 positively recite that the claimed puzzles have "a predefined solution." The Examiner contends that the term "predefined solution" is an intended use limitation and as such has no weight. We disagree with the Examiner's contention that the term "predefined solution" is an intended use limitation. Further, we agree with Appellants that Samberg's card games do not have a "predefined solution." We therefore do not sustain the rejection of the claims as unpatentable over Samberg.

#### *Non-Statutory Subject Matter*

The Examiner determined that the pending claims are "directed to nothing more than an abstract idea in the rules for playing a game." Non-Final Act 7. The Examiner additionally determined that: (1) there is

no sufficient transformation under the machine-or-transformation test “as the cards and players remain the same after performing the steps in the claimed invention;” and (2) the claimed “data processing system” is not a particular apparatus because the game can be played without the use of the data processing system. *Id.* at 7–8.

Appellants argue that their claims recite patent eligible subject matter because they recite additional elements beyond an abstract idea and, in accordance with the machine-or-transformation test, they are (1) “tied to a data processing system,” which is a particular machine, and (2) “recite transformation of specific data,” which qualifies as a particular article, into a different state or thing. Appeal Br. 7, 11.

#### Identification of the Abstract Idea

In *Alice Corp. Party. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), the Supreme Court set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.*

If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298). In other words, the second step is to “search for an ‘inventive concept’—i.e., an element or

combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (alteration in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that the pending claims are directed to a patent-ineligible abstract concept of rules for playing a game. Non-Final Act. 7. The functional language recited in independent claim 1, including the data processing system being configured to provide a puzzle, enable a wager, enable interaction with the puzzle, and determine a score, are directed to abstract processes (or functions) of displaying, collecting, and analyzing information of a specific content. Such information is an intangible. *See Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 451 n.12 (2007). Information display, collection, and analysis, even when limited to particular content, is within the realm of abstract ideas. *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011). The same analysis applies to independent claim 31, which recites a physical processor programmed to receive a puzzle, receive player interaction with the puzzle, receive a wager, determine a score, determine a winner, and allocate winnings.

As recognized by the Federal Circuit in *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014), *Bilski*’s machine-or-transformation test can provide a useful clue in the second step of the *Alice* framework. Under the machine-or-transformation test, a claimed process is

patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus; or (2) it transforms a particular article into a different state or thing. *See Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008).

### Particular Apparatus

Regarding the machine-or-transformation test, Appellants contend that the Examiner erred in requiring that a “particular apparatus” under the machine-or-transformation test be essential to playing the game, and that the claimed data processing system is essential to play of the claimed game.

Appeal Br. 8. According to Appellants, *Bilski* held that an apparatus satisfies the machine-or-transformation test when “(1) use of the data processing system imposes meaningful limits on the claim’s scope, and (2) the involvement of the data processing system in the claimed process is not merely insignificant extra-solution activity.” *Id.* at 9 (citing *In re Bilski*, 545 F.3d at 966). Appellants appear to allege that the recited data processing system (or physical processor) imposes meaningful limits on the claims’ scope because the system performs the functional language set forth in each of the limitations set forth in claims 1 and 31. *Id.* at 9. Appellants further contend that involvement of the data processing system “is not merely insignificant extra-solution activity,” and that the claimed invention “is not merely a game played on a data processing system,” because (1) the claimed data processing system “is related to” software programs executed thereon (e.g., multi-player software gaming applications), (2) can include “mobile phones, personal computers, etc.,” and (3) can be integrated into various social networking platforms. *Id.* at 10 (citing Spec. 15, 16).

Appellants further contend that the claimed data processing system is a particular machine because “a generic computer programmed with specific



programming instructions transforms the generic computer into a special purpose computer.” Appeal Br. 15 (citing *In re Alappat*, 33 F.3d 1526, 1543 (Fed. Cir. 1994)).

The Examiner disagrees, arguing that Appellants have not explained how the data processing system, recited throughout the claims, is essential to play of the game. Ans. 4–5 (citing *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716–17 (Fed. Cir. 2014)).

The Examiner has the better argument. Limiting the abstract concept of rules and steps for playing a game to implementation on a known data processing system does not make the abstract concept patent-eligible under 35 U.S.C. § 101. As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2358 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible); *see also Ultramercial*, 772 F.3d at 715–16 (providing that claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (providing that claims reciting “generalized software components arranged to [generate insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” is not patent eligible).

### Transformation

Appellants also argue that the “puzzle component provided by the system and modified based on player interaction [therewith] represents a

specific type of data that is transformed under the [machine-or-transformation] test.” Appeal Br. 11. Appellants further contend that this transformation of data “is not merely insignificant extra-solution activity . . . because the claimed invention relates to allowing a player to interact with his puzzle component in order to progress toward completion of a solution to compete with other players and win associated wagers.” *Id.* at 12.

The Examiner disagrees, arguing that the alleged transformation of data is not a sufficient transformation, because nothing changes to a different state or derives new capabilities. Ans. 6 (“there is merely a change in location or of indicia and any meaning afforded to the indicia is dictated by the rules themselves”).

The Examiner again has the better argument. The Federal Circuit has held that the following do not satisfy the transformation prong of the machine-or-transformation test: (1) collection and organization of data; and (2) manipulation or reorganization of data. *See CyberSource*, 654 F.3d at 1371, 1375. The court concluded that collecting, organizing, and manipulating data did not satisfy the transformation prong because each action could be performed in the human mind. *See id.* at 1373, 1376–77. Appellants’ own Specification discloses that the claimed providing, enabling, and determining steps need not be performed by a data processing system. *See, e.g.*, Spec. 26–35 (describing “Exemplary Embodiment #1”). Although a data processing system may enhance the claimed method, for example with displays or increased processing speed, each of the steps can nonetheless be performed by a dealer and the players.

Thus, considering the second step of the *Alice* inquiry, we agree with the Examiner that nothing in claims adds “significantly more” to transform

the abstract concept of displaying, collecting, storing, and analyzing information into a patent-eligible application. *See Alice*, 134 S. Ct. at 2357. Rather, the claims simply incorporate a known data processing system to perform the abstract concept of applying rules and performing steps for playing a game, i.e., displaying, collecting, storing, and analyzing information.

### Preemption

Appellants next argue that the claimed invention is directed to statutory subject matter because the claims do not preempt an abstract idea or tie up all action between participants in playing a game. Appeal Br. 12; Reply Br. 3–4.

We are not persuaded by this argument. Although *Alice* was indeed concerned with preemption, the Federal Circuit has stated that “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility. . . . Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, . . . preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics Inc. v. Sequenom Inc.*, 788 F.3d 1371, 1376 (Fed. Cir. 2015). Thus, based on our analysis above, this argument is rendered moot.

### Dependent Claims

Appellants argue that the dependent claims were improperly rejected without individually addressing their claimed features. Appeal Br. 17. The Examiner contends that, to the contrary, “the examiner’s position is directed to all the claims as being patent ineligible and that none of any features of

any of the claims overcome that position.” Ans. 10. Appellants contend, in response, that a prima facie case must be established for each claim independently. Reply Br. 4.

We are not persuaded that the Examiner failed to establish prima facie obviousness of the dependent claims. The Examiner stated that the claimed method steps, generally, are directed to the abstract idea of rules and steps for playing a game. Each of the dependent claims recite rules and steps for playing a game. We decline to find error in the Examiner’s decision not to (1) recite each depended claim limitation separately, (2) state that the limitation recites rules and steps for playing a game, and then (3) state that recited rules and steps for playing a game are an abstract idea.

#### Conclusion

For the reasons set above, we sustain the rejection of the claims under 35 U.S.C. § 101 as directed to non-statutory subject matter.

#### DECISION

We AFFIRM the rejection of claims 1–29 and 31 on the ground of non-statutory double patenting.

We AFFIRM the rejection of claims 1–29 and 31 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

We REVERSE the rejection of claims 1–29 and 31 under 35 U.S.C. § 112, second paragraph.

We REVERSE the rejection of claims 1–29 and 31 under 35 U.S.C. § 103(a) as unpatentable over Samberg.

Appeal 2016-005088  
Application 13/871,531

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED